

Remarks

Upon entry of the present amendment, claims 26-35 and 37-48 are pending in the instant application. Claim 36 has been canceled without prejudice or disclaimer.

Applicants thank the Examiner for acknowledging the allowability of claims 26-35, 37, and 44-48. Applicants respectfully address the Examiner's rejections of the remaining claims below. Should Applicants' arguments be deemed unpersuasive, Applicants further request an interview with the Examiner to discuss any remaining issues prior to the issuance of a further Office Action.

No new matter has been added.

New Matter Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner has maintained the rejection of claims 36 and 39-43 under 35 U.S.C. § 112, first paragraph for allegedly containing new matter. In particular, the Examiner maintains that

[t]he phrase "an isolated cell that produces the antibody or fragment thereof" claimed in claim 36 [sic]; the phrase "at least 30 contiguous amino acid residues of SEQ ID NO:2 in length" claimed in claim 39 (a and c) and the phrase "at least 50 contiguous amino acid residues of SEQ ID NO:2 in length" claimed in claim 39(b and d) represent a departure from the specification and the claims as originally filed

See, page 2, section 8, paragraph 2.

Applicants respectfully disagree and traverse these rejections.

(a) The Examiner has alleged that the recitation of "an isolated cell that produces the antibody or fragment thereof" in claim 36 is creating a "new genus of cells". See, page 3, paragraph 2. Moreover, the Examiner has argued that "entitlement to a filing date does not extend to subject matter which is not disclosed, but would be well-known over what is expressly disclosed." See, page 3, paragraph 1. Applicants respectfully disagree.

Applicants respectfully reiterate that test for the written description requirement is whether the specification conveys to a person of ordinary skill in the art that Applicants were in possession of the claimed invention at the time of the earliest filing date. See, e.g., *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d 1111, 1116 (Fed. Cir. 1991); M.P.E.P. § 2163(I)(B). Moreover, contrary to the Examiner's assertions, the MPEP

clearly states that the knowledge in the art is essential to the evaluation of written description. In particular, MPEP § 2163(II)(A)(1) at 2100-178 states that

a review is conducted from the standpoint of one of skill in the art at the time the application was filed ... and should include a determination of the field of the invention and the level of skill and knowledge in the art. Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. Information which is well known in the art need not be described in detail in the specification. ...

Applicants reiterate that the specification, in combination with the knowledge in the art, conveys with reasonable clarity to a skilled person in the art that Applicants were in possession of the isolated cells claimed in claim 36. However, in the interest of furthering prosecution, and in no way in acquiescence to the Examiner's arguments, Applicants have canceled claim 36 without prejudice or disclaimer. Applicants hereby reserve the right to pursue the canceled subject matter in later filed continuing applications. Applicants assert that the Examiner's rejection of claim 36 is rendered moot and respectfully request the Examiner to withdraw this rejection.

(b) The Examiner has also alleged that specification fails to support the recitation of either at least 30 or at least 50 contiguous amino acid residues. In particular, the Examiner has argued in that the specification on page 46, paragraph 127 allegedly "discloses such position in terms of percentage identity of the polypeptide rather than in the context for epitope-bearing portions of Ependymin polypeptide." *See*, page 3, paragraph 4.

Applicants respectfully disagree and assert that the Examiner has misinterpreted the recited paragraph. Applicants agree that paragraph 127 on page 46 discusses polypeptides with percent identity to the Ependymin polypeptide of SEQ ID NO:2. However, contrary to the Examiner's assertions, the paragraph separately discusses portions of the Ependymin polypeptide of SEQ ID NO:2 that are at least 30 or 50 contiguous amino acids in length. In particular, paragraph 127 on page 46 states that

[t]he polypeptides of the invention also comprise those which are at least 80% identical ... to the polypeptide encoded by the deposited cDNA or to the polypeptide of SEQ ID NO:2, and also include portions of such polypeptides with at least 30 amino acids and more preferably at least 50 amino acids.

Emphasis added. Thus, the specification provides explicit disclosure for recitations of polypeptides at least 30 contiguous amino acids in length and at least 50 contiguous amino acids in length. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

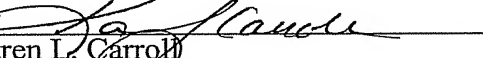
Conclusion

Entry of the above amendment is respectfully solicited. In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance, and an early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicants would expedite the allowance of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an additional extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

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Respectfully submitted,

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